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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,819	09/05/2003	Ming T. Chen		9412
24987	7590	02/15/2005		
MARCUS G THEODORE, PC 466 SOUTH 500 EAST SALT LAKE CITY, UT 84102			EXAMINER BLAU, STEPHEN LUTHER	
			ART UNIT 3711	PAPER NUMBER

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,819

Applicant(s)

CHEN, MING T. 

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 7 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/6/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment dated 6 December 2004 is not in accordance with article 714 II.B. (Manual of Patenting Examining Procedures (MPEP)). Throughout the amendment to the specification the markings "***>" were used in the instructions and in the paragraph being amended. These markings were used in article 714 (MPEP) to only show what change was made to this article in the latest change to the MPEP. These markings were not meant or desired to be included in amendments to applications. The applicant needs to submit these changes to the specification again without these markings. If this is not done in the next response than the response will be considered non-responsive.

2. The amendment 20 August 2004 is not in accordance with article 714 II.C (MPEP) in that the status of claims is not proper. The current status expressions of (amended) and (added) were used. These should have been (currently amended) and (new) should have been used. The applicant needs to submit a new list of claims have the proper current status for each claim in the next response. If this is not done in the next response than the response will be considered non-responsive.

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3. In addition, the amendment 20 August 2004 is not in accordance with rule 37 CFR 1.75 (h) in that claims must commence on a separate sheet and may not contain any other material. The amendment 20 August 2004 contained changes to the specification and claims on the same page. The applicant needs to submit a new list of claims on separate sheets from all other material. If this is not done in the next response then the response will be considered non-responsive.

Drawings

4. The change to the drawings are agreed with and the objection under 37 CFR 1.84(p)(5) is removed.
5. The formal drawings are approved by the examiner.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1-5 and 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 line 20 is indefinite in that the statement "behind the most probable hitting surface" is indefinite. What is probable for

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one golfer may not be what is probable to another. The examiner recommends removing the words "most probable". Claim 1 lines 33-35 are indefinite in that the statement "with most mass placed along the lower portion of the club face most probable to impact a golf ball during repetitive strokes" is indefinite. What is probable for one golfer may not be what is probable to another. The examiner recommends removing the entire statement. Claim 1 line 53 is indefinite in that the statement "the most probable contact segments of". This statement is indefinite for the same reason. The examiner recommends removing the entire statement. Claims 3-4 and 8-9 are indefinite in that these conditions will be different for each golfer and most likely change over time for each golfer due to many different variables. The examiner recommends canceling these claims. Claims 2 and 5 are rejected for depending on rejected base claims.

Allowable Subject Matter

8. Claims 6-7 and 10 are allowed. None of the prior art discloses or renders as obvious a first reinforcing sole weight attached behind a back surface of a the club along the bottom sole with the height rising from a low point proximate a heel increasing along a sole to a peak reinforcing the middle of a lower back surface and thereafter declining to a low point proximate a toe, the depth of its sole mass increasing in thickness from a least thickness from a least thickness proximate the heel and increasing along the bottom of the sole in depth to reinforce the middle and thereafter

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decreasing in thickness to a least thickness proximate a toe along a sole, and a third center weight attached to a back surface behind the hitting surface above a sole weight in addition to the other elements of structure claimed.

9. Claims 1-2 and 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

None of the prior art discloses or renders as obvious a first reinforcing sole weight attached behind a back surface of a the club along the bottom sole with the height rising from a low point proximate a heel increasing along a sole to a peak reinforcing the middle of a lower back surface and thereafter declining to a low point proximate a toe, the depth of its sole mass increasing in thickness from a least thickness from a least thickness proximate the heel and increasing along the bottom of the sole in depth to reinforce the middle and thereafter decreasing in thickness to a least thickness proximate a toe along a sole, and a third center weight attached to a back surface behind the hitting surface above a sole weight in addition to the other elements of structure claimed.

Response to Arguments

10. The argument that claim 1 is not indefinite due the claim being directed to the needs of the individual golfer is disagreed with. In determining the limits of this claim it would be uncertain what golfer to use to do this. In *Ex parte Brummer*, 12 USPQ2d

1653 (Bd. Pat. App. & Inter. 1989) it was determined that a claim may be rendered indefinite by reference to an object that is variable. In this court case an attribute in the form of height to a person which varies was included in the claim and this was determined as being indefinite (See article 2173.05(b) MPEP). In these claims, the terms "most probably hitting surface", "most probable to impact of a ball during repetitive strokes", "most probable contact segments of", "hitting surface where 85% of shots leave a face", and "Gaussian distribution of random repetitive shots" will vary between golfers and as such cause the claims to be indefinite.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 12 February 2005



STEPHEN BLAU
PRIMARY EXAMINER